

R E M A R K S

The office action of February 4, 2005 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1-5, 8, and 10-42, 44-45 and 47-59 remain in this case, claims 6-7, 9, 43 and 46 being cancelled, claims 53-59 being added and claims 1, 8, 10-11, 13-15, 30, 33-39, 42, 45, 47-49 and 51-52 being amended by this response.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

Examiner's Amendment

The Applicant respectfully thanks the Examiners for his comments regarding the priority information and the title. Both sections of the application have been amended according to the Examiner's suggestions.

Objection to the Claims

4. Claims 51 and 52 were objected to as being a substantial duplicate of claims 30 and 32, respectively. The Applicant respectfully disagrees.

"Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough. Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim." (M.P.E.P. 706.03(k)).

Claim 30 includes, in part "a structure of the orifice, the width of the orifice, and the length of the orifice at each location along the orifice are designed such that a linear flow

characteristic is maintained with respect to all locations along the orifice except at the ends of the orifice. In contrast, claim 51 includes, in part, “a structure of the orifice, the width of the orifice, and the length of the orifice at each location along the orifice are designed such that the orifice maintains a substantially constant width with respect to all locations along the orifice except at the ends of the orifice.” These claims are different- they do not cover the same thing. The Applicant is restating the invention in different ways, as MPEP 706.03(k) permits.

The Examiner quotes section 2114 of the MPEP to support his argument that the claims are duplicates. The Applicant does not believe that section 2114 is relevant when determining whether claims are “substantial duplicates” of each other in the same application. Instead, section 2114 specifically discusses the comparison between apparatus claims and the prior art. Therefore, it is not relevant when determining whether two claims in the same application are duplicates.

Since claims 51 and 52 are not substantial duplicates of claims 30 and 32, Applicant respectfully requests that the rejection be withdrawn.

Rejection under 35 U.S.C. §112

7. Claims 45-50 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 has been amended to overcome this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

11. Claims 1, 2, 3, and 5 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13 and 19 of U.S. patent No. 6,748,765. Claim 1 has been amended to overcome this rejection.

More specifically, claim 1 has been amended to include the limitation of claim 6 (which the Examiner stated was allowable) into the claim. Reconsideration and withdrawal of the rejection is respectfully requested.

13. Claims 30-32, 42, 43, 51 and 52 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 22 of U.S. Patent No. 6,748,765. Claims 30 and 51 have been amended to overcome this rejection.

Claim 30 now includes, in part, “as the width of the orifice changes during a duration of a production campaign as the orifice deforms due to thermal creep caused by internal hydrostatic pressure a structure of the orifice, the width of the orifice, and the length of the orifice at each location along the orifice are designed such that a linear flow characteristic is maintained with respect to all locations along the orifice except at the ends of the orifice.” (emphasis added). The properties of the orifice continue to be designed during the duration of a production campaign; they are not future properties inherent in the structure. Therefore, as amended, claim 30 does not claim the same invention as that of claim 22 in U.S. Patent No. 6,748,765. Reconsideration and withdrawal of the rejection of claim 30 is respectfully requested.

Claims 31-32, and 42-43, being dependent upon and further limiting claim 30, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection of claims 31-32 and 42-43 are respectfully requested.

Claim 51 now includes, in part, “wherein as the forming apparatus changes shape during the duration of a production campaign as the orifice deforms due to thermal creep caused by internal hydrostatic pressure, a structure of the orifice, the width of the orifice and the length of the orifice at each location along the orifice are designed such that the orifice maintains a substantially constant width with respect to all locations along the orifice except at the ends of the orifice” (emphasis added). The properties of the orifice continue to be designed during the duration of a production campaign; they are not future properties inherent in the structure. Therefore, as amended, claim 51 does not claim the same invention as that of claim 22 in U.S. Patent No. 6,748,765. Reconsideration and withdrawal of the rejection of claim 51 is respectfully requested.

Claim 52, being dependent upon and further limiting claim 51, should also be allowable for that reason, as well as for the additional recitations it contains. Reconsideration and withdrawal of the rejection of claim 52 are respectfully requested.

15. Claim 45 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 56 of U.S. Patent No. 6,748,765. Claim 45 has been amended to overcome this rejection.

More specifically, claim 45 has been amended to include the limitation of claim 46 (which the Examiner stated was allowable) into the claim. Reconsideration and withdrawal of the rejection is respectfully requested.

16. Claims 33 and 44 were rejected under the judicially created doctrine of double patenting over claims 23 and 24 of U.S. patent No. 6,748,765.

Claim 30, upon which claims 33 and 44 depend, should now be allowable. Claims 33 and 44, being dependent upon and further limiting claim 30, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection of claims 33 and 44 is respectfully requested.

Allowable Subject Matter

19. Applicant gratefully acknowledges Examiner's statement that claims 23-29 are allowable.
20. Claims 4, 6-22 and 34-41 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 6 has been incorporated into claim 1, which should now be allowable. Claim 30, upon which claims 34-41 depend, should also now be allowable. In addition, claims 4, 19/20, 10, 34-36 and 39 have been included as new independent claims 53, 54, 57, 58, and 59, respectively. Reconsideration and withdrawal of the objection is respectfully requested.
21. The Examiner stated that claims 46-50 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, and to include all of the limitations of the base claim and any intervening claim. Such action has been taken (claim 46 has been incorporated into

claim 45), as noted in the arguments above. Claims 45 and 47-50 should now be allowable.

Conclusion

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

Richard B. Pitbladdo

By: 

Meghan Van Leeuwen, Reg. No. 45,612
Attorney for Applicant

BROWN & MICHAELS, P.C.
400 M&T Bank Building - 118 N. Tioga St.
Ithaca, NY 14850
(607) 256-2000 • (607) 256-3628 (fax)
e-mail: docket@bpmlegal.com
Dated: 3/9/05